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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,561	06/02/2006	Katsuhiro Ando	062554	5391
38834 7590 03/23/2009 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER LOEWE, ROBERT S				
ART UNIT		PAPER NUMBER		
1796				
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03/23/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,561

Applicant(s)

ANDO ET AL.

Examiner

ROBERT LOEWE

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date 10/9/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's amendments have caused the previously relied upon prior art rejections to be withdrawn. However, new grounds of rejection are made below; the new rejections being a result of Applicants amendments to the claims.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al. (WO-30/11978). For convenience, the English-language equivalent US Pat. 7,115,695 will be relied upon.

Claims 2 and 4-8: Okamoto et al. teaches a curable composition comprising a silicon-group terminated polyoxypropylene polymer (EP505S, Table 1), laurylamine, which is a primary amine having a melting point of greater than 20 degrees C, an epoxy resin (Epikote 828, Table

1), water, and calcium carbonate fillers (Table 1). The amounts of these ingredients satisfy those required by instant claims 2 and 4. Okamoto et al. further teaches that when an epoxy resin is present, a curing agent of the epoxy resin may be added (20:30-44) in amounts which satisfy instant claim 1 (20:45-53). Okamoto et al. teaches that the curing agent of the epoxy resin includes 2,4,6-tris(dimethylaminomethyl)phenol (20:36-37). Okamoto et al. further teaches the addition of silane coupling agents (21:6), which may be present in amounts required by instant claim 1 (Example 5, Table 2). Okamoto et al. either directly teaches or suggests every ingredient required by instant claim 1. Okamoto et al. also directly teaches or suggests that the amount employed for each ingredient falls within the ranges of instant claim 1. While the teachings of Okamoto et al. do not warrant a case of anticipation regarding instant claim 1, such a teaching is nevertheless obvious. Specifically, starting with the compositions in Table 1, a person having ordinary skill in the art would only need to add a curing agent for the epoxy resin which Okamoto et al. explicitly teaches, and further add a silane adhesion promoter, which Okamoto et al. explicitly teaches in another preferred embodiment to arrive at the instant claimed invention. Last, Okamoto et al. teaches that the curable compositions therein may serve as coating/sealing materials (21:17-32).

Claim 3: While Okamoto et al. does not explicitly teach the claimed viscosity and structural viscosity index required by instant claim 3, Okamoto et al. is cognizant about obtaining workable viscosities (15:44-48). It is very well known that adjusting the viscosity of a composition a within the realm of routine experimentation. A person having ordinary skill in the art appreciates the processing difficulties which may arise should the viscosity of the curable composition be too high or too low. Further, since Okamoto et al. teaches compositions

comprising the same claimed ingredients, it is believed that the compositions taught by Okamoto et al. would have the same physical properties as claimed.

Relevant Art Cited

The prior art made of record and not relied upon but is considered pertinent to applicants disclosure can be found on the attached PTO-892 form.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./
Examiner, Art Unit 1796
18-Mar-09

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796